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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,641	06/05/2000	HIROKATSU SHIMADA	15162/02070	7764

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EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/586,641

Applicant(s)

SHIMADA, HIROKATSU

Examiner

Thierry L Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 11-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention is a computer related invention. The Computer-Implemented Invention Guidelines issued by the U.S. Patent and Trademark Office describe the procedures for examining such inventions. The first step is to determine whether the invention as defined by the claims falls within one of the three following categories of unpatentable subject matter: (1) Functional descriptive material such as a data structure *per se* or a computer program *per se*, (2) Non-functional descriptive material such as music, literary works or pure data, embodied on a computer readable medium; or (3) A natural phenomenon such as energy or magnetism. The invention as defined by the claims is not a natural phenomenon or pure data, however, it is a computer program *per se*, which does not mount/store on any computer-readable medium; therefore, these claims are rejected for non-statutory basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-3, 6-8, 11-13, 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Yacoub (U.S. 6552813).

Regarding claim 1, Yacoub discloses a printer control device (server, Fig. 3 & 4) which controls multiple printers (Fig. 4) connected to a network circuit, said printer control device comprising:

(a) a detector (a detecting means is incorporated within a server, col. 4, lines 28-52) for detecting a problem in any of the printers;

(b) a selection controller (server, Fig. 3, col. 4, lines 5-67 and col. 5, lines 1-12) for selecting, when a problem is detected by the detector, another normally functioning printer to substitute for the printer in which the problem is detected by said detector; and

(c) a substitution controller (server, Fig. 3, col. 4, lines 5-67 to col. 5, lines 1-10, and col. 6, lines 46-67 to col. 7, lines 1-36) for correcting print data, that was to have been printed out by the printer in which the problem is detected by said detector, to ensure that quality of the images printed by the selected substitute printer is the same (preferences that the users or client selected at his station for the print job relating to quality, speed and color or black and white, col. 7, lines 10-37 and col. 12, lines 38-62) as that of the images printed by the printer in which the problem is detected, and for outputting the corrected print data to the selected substitute printer.

Regarding claim 2, Yacoub further discloses a printer control device as claimed in claim 1, wherein the print data includes color print data that indicates a color image (color image

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preferences, col. 4, lines 24-67, and col. 6, lines 46-67 to col. 7. lines 1-36), and said substitution controller performs correction so that a color characteristic of the color image printed by the printer in which the problem is detected are the same as that of the color image printed by the selected substitute printer.

Regarding claim 3, Yacoub further discloses a printer control device as claimed in claim 1, wherein the print data includes middletone print data that indicates a middletone image (black and white preferences, col. 4, lines 24-67, and col. 6, lines 46-67 to col. 7. lines 1-36), and the substitution controller performs correction so that a gradation characteristic of the middletone image printed by the printer in which the problem is detected are the same as the gradation characteristic of the middletone image printed by the selected substitute printer.

Regarding claims 6-8: Claims 6-8 are the method claims corresponding to the apparatus claims 1-3 (respectively). The method claims are inherent and included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 1-3 above.

Regarding claims 11-13: claims 11-13 correspond to claims 1-3 (respectively) except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers/servers have some type of computer readable memory medium (i.e. storage for storing operating system, Fig. 5) for storing computer programs, hence claims 11-13 should be rejected using the same rationale as in claims 1-3.

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Regarding claims 16-18: Claims 16-18 recite the limitations that are included in claims 1-3; therefore, claims 16-18 is rejected for the same basis/rationale as described in claims 1-3 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4, 9, 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacoub as applied to claim 1 above, and in view of Hirofumi et al (JP 410301737A).

Regarding claim 4: Yacoub as described in claim 1 above, does not disclose explicitly wherein said substitution controller outputs to the selected substitute printer the print data for remaining pages not printed by the printer in which the problem is detected.

Hirofumi, in the same field of endeavor for detecting failure printers in the network, discloses substitution controller outputs to the selected substitute printer the print data for remaining pages (abstract and computer-translation, p.3, paragraph 14) not printed by the printer in which the problem is detected.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Yacoub as per teachings of Hirofumi (print remaining pages) because of a

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following reason: to increase printing capability and to eliminate the waiting time when errors occurred within the networked printers (col. 3, lines 23-47 and col. 10, lines 50-65).

Therefore, it would have been obvious to combine Hirofumi with Yacoub to obtain the invention as specified in claim 4.

Regarding claim 9: Claim 9 is the method claims corresponding to the apparatus claim 4. The method claims are inherent and included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claim 4 above.

Regarding claim 14: claims 14 correspond to claim 4 except computer readable memory medium for storing program is claimed rather than printing system or data output/control apparatus. All computers/servers have some type of computer readable memory medium (i.e. storage for storing operating system, Fig. 5) for storing computer programs, hence claim 14 should be rejected using the same rationale as in claim 4.

Regarding claim 19: Claim 19 recites the limitations that are included in claim 4; therefore, claim 19 is rejected for the same basis/rationale as described in claim 4 above.

3. Claims 5, 10, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacoub as applied to claim 1 above, and in view of Otsuka (U.S. 6424425).

Regarding claim 5, Yacoub as described in claim 1 above, does not disclose explicitly wherein multiple printers includes a copying machine.

Otsuka, in the same field of endeavor for printing, discloses wherein the printers include a copying machine (Fig. 1 shows a multi-functional printing apparatus which includes a copy machine function, col. 3, lines 36-42).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Yacoub as per teachings of Otsuka (printers include copying machine function) because of a following reason: to increase printing capability and to eliminate the waiting time when errors occurred within the networked printers (col. 3, lines 23-47 and col. 10, lines 50-65).

Therefore, it would have been obvious to combine Otsuka with Yacoub to obtain the invention as specified in claim 5.

Regarding claim 10: Claim 10 is the method claims corresponding to the apparatus claim 5. The method claims are inherent and included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claim 5 above.

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Regarding claim 15: claim 15 corresponds to claim 5 except computer readable memory medium for storing program is claimed rather than printing system or data output/control apparatus. All computers/servers have some type of computer readable memory medium (i.e. storage for storing operating system, Fig. 5) for storing computer programs, hence claim 15 should be rejected using the same rationale as in claim 5.

Regarding claim 20: Claim 20 recites the limitations that are included in claim 5; therefore, claim 20 is rejected for the same basis/rationale as described in claim 5 above.

Conclusion

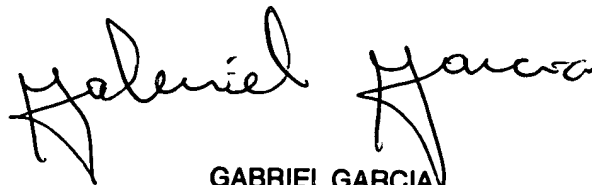
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is (703)308-5397.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Thierry L. Pham

December 5, 2003


GABRIEL GARCIA
PRIMARY EXAMINER